

### **REMARKS**

In the Office Action mailed October 1, 2010, the Examiner (1) rejected claims 1, 4-13, 16-25, 28-37, and 40-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,422,821 ("*Allen*") in view of a webpage for "NCOA Description" from www.Anchorcomputer.com (Reference U of the PTO-892) ("*Anchor*"); and (2) rejected claims 57-64 under 35 U.S.C. § 103(a) as being unpatentable over *Allen* in view of U.S. Patent Application Pub. No. 2002/0029202 A1 ("*Lopez*") and in further view of *Anchor*. Claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 remain pending and under current examination.

#### **Regarding Office Action's Response to Arguments**

In the "Response to Arguments" section, the Office Action alleged that "*Anchor* describes a system that not only corrects incorrect addresses due to moves, but also due to delivery format errors in the Zip codes" and that *Anchor* stores the incorrect and resolved address in a database. O.A. at 3-4. Applicants respectfully disagree. While *Anchor* may disclose correcting Zip codes for addresses, *Anchor* fails to disclose or suggest that the uncorrected address is stored in the database.

The Office Action alleged that the NCOA database stores "old or undeliverable addresses along with a new/correct address." O.A. at 4. This is not correct. While the NCOA database may store old addresses, it does not store undeliverable addresses. The claims do not recite storing old addresses. The independent claims recite storing the "incorrect address that contains the delivery format error." The Office Action does not identify any specific text of *Allen* or *Anchor* disclosing or suggesting a database that

stores an address having such a delivery format error. Both *Anchor* and *Allen* merely disclose storing former addresses, which do not contain delivery format errors.

Therefore, for at least the above reasons, the stored addresses of *Allen* and *Anchor* in the NCOA database do not constitute or suggest “a resolved address comprising ... an incorrect address that contains a delivery format error,” as recited in claim 1 (emphasis added).

Regarding Rejections of Claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 under 35 U.S.C. § 103(a). No *prima facie* case of obviousness has been established with respect to these claims.

To establish a *prima facie* case of obviousness, the Office Action must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A). Furthermore, the Office Action must make findings with respect to all of the claim limitations and must make “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See *Id.* §§ 2143.03 and 2141(III).

Claim 1 recites, among other things, the following elements:

receiving a first instance of an incorrect address that contains a delivery format error, the incorrect address being associated with a first item;

resolving the first instance of the incorrect address to determine a correct address in a predetermined delivery format by using at least one of a plurality of address resolution processes;

in response to resolving the first instance of the incorrect address, storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error; [and] . . .

comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address.

The Office Action conceded that *Allen* does not teach or suggest “a first instance of an incorrect address . . . associated with a first item,” an “incorrect address that contains a delivery format error,” and “storing a resolved address in a database,” as recited in claim 1. O.A. at 2, 5. However, the Office Action then alleged that *Allen* discloses “comparing the second instance of the incorrect address to the stored resolved address.” O.A. at 5. *Allen* cannot both fail to teach “storing a resolved address in a database” while teaching “comparing the second instance of the incorrect address to the stored resolved address.” For at least these reasons, *Allen* does not teach or suggest, among other things, “a first instance of an incorrect address that contains a delivery format error, the incorrect address being associated with a first item,” “storing a resolved address comprising . . . the incorrect address that contains the delivery format error” and “comparing the second instance of the incorrect address to the stored resolved address,” as recited in claim 1.

The Office Action alleged that *Anchor* teaches “receiving a first instance of an incorrect address that contains a delivery format error the incorrect address being associated with a first item.” O.A. at 5. However, this is not correct. *Anchor* discloses identifying addressing errors and correcting them “before mail enters the mail stream.” *Anchor* at p. 1 (emphasis added). A table on page 2 of *Anchor* shows that the incorrect

address comes from a mail file, not an item, and *Anchor* explains that the system “processes your lists and makes all necessary address corrections.” *Anchor* at p. 2 (emphasis added). Address lists and files are not mail items. For at least this reason *Anchor* fails to disclose “receiving a first instance of an incorrect address that contains a delivery form error, the incorrect address being associated with a first item,” as recited by claim 1.

The Office Action also alleged that *Anchor* teaches “storing a resolved address in a database; the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error.” O.A. at 5. Applicants respectfully disagree. *Anchor* discloses a database of former addresses, not “incorrect addresses containing delivery format errors.” The former addresses in the NCOA database do not contain delivery format errors. Although the Office Action alleged that the NCOA database of *Anchor* stores undeliverable addresses (O.A. at 4), the Office Action did not cite to any portion of *Anchor* to support this allegation. Rather, the Office Action referred to the entire reference generally. While *Anchor* may disclose that the mailing list of a customer may contain undeliverable addresses, this mailing list is not a database that stores “a resolved address . . . comprising the correct address and the first instance of the incorrect address,” as recited in claim 1.

Moreover, *Anchor* does not disclose or suggest “comparing the second instance of the incorrect address to the stored resolved address,” as recited in claim 1, for the same reasons as those discussed above with regard to *Allen*. Namely, as recited in claim 1, the stored resolved address is stored in response to resolving the incorrect address, and comprises the incorrect address that contains the delivery format error.

*Anchor* does not disclose or suggest storing a resolved address comprising the incorrect address that contains the delivery format error. Therefore, *Anchor* cannot disclose or suggest comparing a second instance of the incorrect address with the resolved address.

For at least these reasons, even if *Anchor* is combined with *Allen*, as proposed by the Office Action, the combination still fails to disclose or suggest at least “receiving a first instance of an incorrect address that contains a delivery format error, the incorrect address being associated with a first item,” “in response to resolving the first instance of the correct address, storing a resolved address comprising . . . the incorrect address that contains the delivery format error” and “comparing the second instance of the incorrect address to the stored resolved address,” as recited in claim 1.

The Office Action cited *Lopez* as allegedly teaching processing of the first item for delivery in an item delivery system using the correct address and wherein the first item comprises one of a letter and a package, and obtaining the first instance of the incorrect address from the surface of the first item. O.A. at 9. Even assuming the Office Action’s characterization of *Lopez* is correct, which Applicants do not concede, *Lopez* fails to cure the deficiencies of *Anchor* and *Allen*, discussed above. That is, *Lopez*, also, fails to teach or suggest “receiving a first instance of an incorrect address that contains a delivery format error, the incorrect address being associated with a first item,” “in response to resolving the first instance of the correct address, storing a resolved address comprising . . . the incorrect address that contains the delivery format error” and “comparing the second instance of the incorrect address to the stored resolved address,” as recited in claim 1.

For at least the foregoing reasons, *Allen*, *Lopez*, and *Anchor*, whether taken alone or in combination, fail to teach or suggest the elements recited in claim 1, and the Office Action has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established for claim 1, and it is allowable over the cited references. Dependent claims 4-12 and 57-59 are also allowable, at least by virtue of their dependence from claim 1, as well as by virtue of reciting additional elements not taught or suggested by the cited references.

Although of different scope, independent claims 13, 25, and 37 include elements similar to those discussed above in connection with claim 1. For at least the same reasons discussed above with respect to claim 1, independent claims 13, 25, and 37 are allowable over the cited references. Dependent claims 16-24, 28-36, 40-48, and 60-64 are also allowable, at least by virtue of their dependence from one of independent claims 13, 25, or 37, as well as by virtue of reciting additional elements not taught or suggested by the cited references.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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